# UNITED STATES PATENT AND TRADEMARK OFFICE

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/687,412 | 10/12/2000 | Howard J. Glaser | STL920000092US1 | 1235 |

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| EXAMINER |
|---|
| GROSS, KENNETH A |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2122 | |

DATE MAILED: 05/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 07-01)

# Office Action Summary

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL.**      2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)☒ Claim(s) _1-15_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-15_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

## Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____ .

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
        application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _2_ .

4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____ .

## DETAILED ACTION

### *Double Patenting*

1.      The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees.  See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application.  See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer.  A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2.      Claims 1-15 are provisionally rejected under the judicially created doctrine of

obviousness-type double patenting as being unpatentable over claim 1 of copending Application

No. 09/687,033.  Although the conflicting claims are not identical, they are not patentably

distinct from each other because Claim 1 of the copending application No. 09/687,033 teaches

defining a configuration of the application program corresponding to a particular user of the

application program, determining that the stored configuration corresponds to the user, and

building the application program based on the information provided in the configuration file, as

taught in Claim 1 of the application. Claim 1 of the copending application No. 09/687,033

further teaches encrypting and storing the configuration in a manifest file, authenticating the user

in response to the user requesting the application program, and decrypting the manifest file in

response to the user authentication, as taught in Claim 2 of the application. The current

application teaches updating an application program whereas the copending application No.

09/687,033 teaches installing an application program. However, since both applications build an

application program for execution on a data processing system, it would be obvious that the

current application also installs the application program with the updated item on the data

processing system.

This is a _provisional_ obviousness-type double patenting rejection because the conflicting

claims have not in fact been patented.

3.      Claims 1-15 are provisionally rejected under the judicially created doctrine of

obviousness-type double patenting as being unpatentable over claims 1 and 2 of copending

Application No. 09/687,414. Although the conflicting claims are not identical, they are not

patentably distinct from each other because Claims 1 and 2 of copending application No.

09/687,414 correspond with elements of Claim 1, 3, 4, and 5 of the current application. The

Claims of the current application do not teach "initiating a session between the local and remote

data processing system in response to the user requesting the application program." However, it

is obvious to one of ordinary skill in the art to initiate a session between two computers before

data transfer is initialized, since both computers need to be connected and aware that a transfer is

about to take place.

This is a _provisional_ obviousness-type double patenting rejection because the conflicting

claims have not in fact been patented.

### Claim Rejections - 35 USC § 112

4.      The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the
> subject matter which the applicant regards as his invention.

5.      Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for

failing to particularly point out and distinctly claim the subject matter which applicant regards as

the invention.

6.      Claims 1, 6, and 11 recite the limitations "the stored configuration" and "the requesting

user". There is insufficient antecedent basis for these limitations in the claim. Claims 3, 8, and

13 recite the limitation "the user authentication". There is insufficient antecedent basis for this

limitation in the claims. Claims 3-5, 8-10, and 13-15 recite the limitations "the remote data

processing system" and "the local data processing system". There is insufficient antecedent basis

for these limitations in the claims. Furthermore, it is unclear from the language how many data

processing systems there are, and which of these two limitations corresponds to the data

processing system first mentioned in Claims 1, 6, and 11. It will be interpreted that there are two

data processing systems, and that the local data processing system is the data processing system

mentioned in Claims 1, 6, and 11. Claims 1-3, 6-8, and 11-13 recite the limitation "the item" in

the "retrieving an updated item" step of these claims. It is unclear as to which item "the item" is

referring to. It is understood that "the item" represents any items that have been updated, as

discovered in the previous step, however, this needs to be corrected. Claims 1-3, 6-8, and 11-13

recite the limitations "have been updated" and "has been updated". It is unclear as to exactly

what it means to be "updated". Does "updated" mean that the items specific to the application

configuration have already been updated in the application, or that the general item has updates

available elsewhere that the application is in need of? Claims 1-2, 6-7, and 11-12 recite the

limitation "building the application program". What does it mean specifically to build the

application program? It was stated previously that the application program currently exists. So,

does "building the application program" actually imply *rebuilding* of the application program?

Or simply updating the application program with the updated item?

### *Claim Rejections - 35 USC § 102*

7.      The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8.      Claims 1, 6, and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Kenner et

al. (U.S. Patent Number 6,314,565).

In regard to Claim 1, Kenner teaches: (a) defining a configuration of the application

program corresponding to a particular user of the application program (Column 7, lines 5-12);

(b) determining whether the configuration corresponds to the user. Since the information is

pulled from the user's computer registry, it must correspond with the requesting user; (c)

determining if any items described in the configuration have been updated (Column 7, lines 12-

16); (d) retrieving an updated item if the item has been updated (Column 8, lines 18-29); (e)

building the application program with the updated item (Column 8, lines 30-41). Claims 6 and 11

correspond directly with Claim 1, and are rejected for the same reasons as Claim 1.

### *Claim Rejections - 35 USC § 103*

9.      The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

10.     Claims 2, 7, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Kenner et al. (U.S. Patent Number 6,314,565) in view of Hsu (U.S. Patent Number 5,894,515).

In regard to Claim 2, Kenner teaches the article of manufacture of Claim 1, and further

teaches: (a) storing the configuration in a manifest file (Column 7, lines 8-12 and lines 17-32);

(b) determining if any items described in the configuration have been updated (Column 7, lines

12-16); (c) retrieving an updated item if the item has been updated (Column 8, lines 18-29); (d)

building the application program with the updated item (Column 8, lines 30-41). Kenner does not

teach encrypting the configuration, authorizing a user in response to a user request for the

application program, and decrypting the manifest file to produce a decrypted configuration. Hsu,

however, does teach encrypting data, authorizing a user, and in response to authorizing a user,

decrypting the data (Column 1, lines 13-21). Therefore it would have been obvious to one of

ordinary skill in the art at the time of the invention to perform a method for updating software

with a configuration file as taught by Kenner, where the configuration file is encrypted and

decrypted only in response to a user authentication, as taught by Hsu, since computer

configuration information may contain sensitive data, and encryption allows only authorized

users to access the data. Claims 7 and 12 correspond directly with Claim 2, and are rejected for

the same reasons as Claim 2.

11.     Claims 3, 4, 8, 9, 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Kenner et al. (U.S. Patent Number 6,314,565) in view of Hsu (U.S. Patent Number

5,894,515) and further in view of Hayes, Jr. (U.S. Patent Number 6,205,476).

In regard to Claim 3, Kenner teaches the article of manufacture of Claim 1, and further

teaches: (a) storing the configuration in a manifest file (Column 7, lines 8-12 and lines 17-32);

(b) determining if any items described in the configuration have been updated (Column 7, lines

12-16); (c) retrieving an updated item from a remote data processing system according to the

configuration if the item has been updated (Column 8, lines 18-29 and Figure 3). Kenner does

not teach encrypting the configuration, authorizing a user in response to a user request for the

application program, and decrypting the manifest file to produce a decrypted configuration. Hsu,

however, does teach encrypting data, authorizing a user, and in response to authorizing a user,

decrypting the data (Column 1, lines 13-21). Neither Kenner nor Hsu teach downloading the

manifest file from the remote data processing system to the local data processing system. Hayes,

however, does teach storing user-specific application configuration preferences, and transmitting

the preferences to the local user system (Column 22, lines 55-59). Therefore it would have been

obvious to one of ordinary skill in the art at the time of the invention to perform a method for

updating software with a configuration file as taught by Kenner, where the configuration file is

encrypted and decrypted only in response to a user authentication, as taught by Hsu, since

computer configuration information may contain sensitive data, and encryption allows only

authorized users to access the data, where the configuration file is stored on the remote system

and transferred to the local system, since this allows for a more organized and more central

repository of user application preferences. Claims 8 and 13 correspond directly with Claim 3,

and are rejected for the same reasons as Claim 3.

In regard to Claim 4, Kenner teaches downloading data from the remote system to the local system based on the configuration (Column 7, lines 12-16 and Column 8, lines 18-29). Claims 9 and 14 correspond directly with Claim 4, and are rejected for the same reasons as Claim 4.

12.    Claims 5, 10, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kenner et al. (U.S. Patent Number 6,314,565) in view of Hsu (U.S. Patent Number 5,894,515) and further in view of Hayes, Jr. (U.S. Patent Number 6,205,476) and Houssain et al. (U.S. Patent Number 5,581,749).

In regard to Claim 5, Kenner, Hsu, and Hayes teach the article of manufacture of Claim 3, and Kenner further teaches downloading data from the remote system to the local system based on the configuration (Column 7, lines 12-16 and Column 8, lines 18-29), and Hsu teaches allowing only authorized users to access encrypted data, but neither Kenner, nor Hsu, and nor Hayes teach authenticating a user in response to a user request for a program. Houssain, however, does teach this method (Figure 9A, items 910 and 914). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to perform a method for updating software with a configuration file as taught by Kenner, where the configuration file is encrypted and decrypted only in response to a user authentication, as taught by Hsu, where the configuration file is stored on the remote system and transferred to the local system as taught by Hayes, and the user is authenticated in response to a user request, as taught by Houssain, since it would be unnecessary to authenticate users who do not request software. Claims 10 and 15 correspond directly with Claim 5, and are rejected for the same reasons as Claim 5.

*Conclusion*

13.    The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure:

Hendrickson et al (U.S. Patent Number 5,933,646) teaches storing a user personality file

(Column 9, lines 38-50).

Win et al. (U.S. Patent Number 6,161,139) teaches user authentication and a registry .

server with encrypted information.

Kroening et al. (U.S. Patent Number 6,080,207)

Manduley (U.S. Patent Number 5,956,505)

Walden, Jr. et al. (U.S. Patent Number 6,052,531)

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Kenneth A Gross whose telephone number is (703) 305-0542.

The examiner can normally be reached on Mon-Fri 7:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Gregory A Morse can be reached on (703) 308-4789.  The fax phone numbers for the

organization where this application or proceeding is assigned are (703) 746-7239 for regular

communications and (703) 746-7240 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the receptionist whose telephone number is (703) 305-3900.

KAG
May 1, 2003
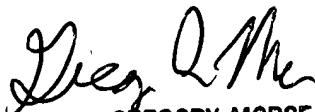
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